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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,373	10/29/2003	Gregory Winfield Gorman	412589	6754
30955 7590 12/28/2009 LATHROP & GAGE LLP 4845 PEARL EAST CIRCLE SUITE 201 BOULDER, CO 80301				
EXAMINER CHEVALIER, ALICIA ANN				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
12/28/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@lathropgage.com

# Office Action Summary

**Application No.**

10/696,373

**Applicant(s)**

GORMAN, GREGORY WINFIELD

**Examiner**

ALICIA CHEVALIER

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8, 21, 22 and 25-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8, 21, 22 and 25-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

**RESPONSE TO AMENDMENT**

1. In view of the Appeal Brief filed on August 8, 2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

./David R. Sample/

Supervisory Patent Examiner, Art Unit 1794

2. Claims 1-3, 5, 6, 8, 21, 22 and 25-32 are pending.

***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §102 rejection over Parker (US Patent No. 5,323,652), made of record in the office action mailed January 22, 2009, page 2, paragraph #3 has been withdrawn due to Applicant's arguments in the appeal brief filed August 21, 2009.
4. The 35 U.S.C. §102 rejection over Arora (US Patent No. 7,048,971), made of record in the office action mailed January 22, 2009, page 3, paragraph #4 has been withdrawn due to Applicant's arguments in the appeal brief filed August 21, 2009.
5. The 35 U.S.C. §103 rejection over Arora (US Patent No. 7,048,971) in view of Hornsby, Jr. (US Patent No. 4,032,687) and Parker (US Patent No. 5,323,652), made of record in the office action mailed January 22, 2009, pages 3-4, paragraph #5 has been withdrawn due to Applicant's arguments in the appeal brief filed August 21, 2009.

***NEW REJECTIONS***

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-3, 5, 6, 8, 21, 22 and 25-32 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the instant case claims 1 and 25 contain(s) the limitation “wherein the difference in water reactivates renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point.” First, the breadth of the claims is not with the scope of enablement provided to one skilled in the art by the disclosure. The condensation point temperature is dependent on the material/fluid and pressure, e.g.  $PV=nRT$ . Second the nature of the invention is a label/sticker on container. The state of the prior art is dependent on temperature or wetness by water only. Next, the level of one of ordinary skill in the sticker/label art would does not necessarily have knowledge of advanced chemistry and physics which is required to determine the atmospheric conditions along with the properties of all usable materials. The level of predictability in the art is only dependent on temperature or wetness by water. The inventor has not provided any direction since they have not given any working examples of their symbol-bearing receptacles. The inventor needs to provide what the material is that has the condensation point and what the temperature would be at different atmospheric conditions. There would be undo experimentation one of ordinary skill in the art to make or use the invention based on the content of the disclosure. Therefore, Applicant’s specification is not enabled for the overly board limitation “wherein the difference in water reactivates renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point.”

9. Claims 1-3, 5, 6, 8, 21, 22 and 25-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 25 are indefinite because they fail to set forth the composition or structure of the container and only claim properties of the container. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. *Ex parte Slob* (PO BdApp) 157 USPQ 172. In the instant case, claims 1 and 25 recite "wherein the difference in water reactivates renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point," which is vague, indefinite, and functional because the temperature at the condensation point varies depending on the type of the material used for the container and the fluid.

The limitation "when a temperature of said container is reduced to a condensation point" in claims 1 and 25 is unclear and renders the claims vague and indefinite. It is unclear what condensation point the container temperature is being lowered to, water, the fluid in the container, the container's material, etc. Furthermore, if it's the temperature at the condensation point for water or the fluid, at what altitudes the temperature being measured, given that the condensation temperature point for water will be different at sea level than at high altitudes.

The limitation "water reactivity" in claims 1 and 25 is unclear and renders the claims vague and indefinite. It is unclear what the reactivity is, beading, absorption, repelling, attraction, etc..

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

10. Applicant's arguments in the appeal brief filed August 21, 2009 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

#### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/  
Primary Examiner, Art Unit 1794  
12/24/2009